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EXAMINER

HOEL, MATTHEW D

ART UNIT PAPER NUMBER

3713

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,205

Applicant(s)

O'DONNELL ET AL.

Examiner

Matthew D. Hoel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 37-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/08/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The examiner notes the following terminology in the specification: LAACS (Lottery Authority Administrative Control System) and MGM (Master Game Matrix). The LAACS does back-office operations, including enabling control of the LAACS locally or remotely (Page 8, 2nd Para.), and controlling the input, storage, retrieval, output, distribution, and display of player data, game data, and retailer data between computing apparatuses of a lottery authority or of multiple authorities (Page 8, 3rd and 5th Para.). The MGM does front-office operations, including keeping age and location qualifications (Page 15, 2nd Para.), controlling which game can be played (Page 15, 3rd Para.), logging purchases through the lottery website (Page 21, 2nd Para.), and lottery financial bookkeeping and auditing (Page 21, 3rd Para.).

Election/Restrictions

2. Applicant's election without traverse of Group I, Claims 1 to 36 in the reply filed on Mar. 10th, 2006 is acknowledged. Claims 37 to 64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Mar. 10th, 2006. These claims will have to be cancelled should the application come into condition for allowance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

4. A person shall be entitled to a patent unless –

5. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 to 9 and 19 to 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Muniz (WIPO publication WO 01/74460 A2, application PCT/IB01/00666).

7. As to Claim 1: '460 teaches a lottery method for at least two lottery authorities, wherein at least one of the participating lottery authorities originates a respective lottery game comprising a set of tickets (multiple jurisdictions, each with own game, Fig. 1a; multiple tickets, Page 21, Lines 2 to 8). '460 teaches PowerBall TM, which is a multi-state lottery game in which each participating jurisdiction enters into an agreement to sell PowerBall TM tickets (Page 7, Lines 17 to 24). It is inherent that all of the participating lotteries in PowerBall TM specify that at least one of the participating lottery authorities is authorized to sell at least one of the lottery tickets of the respective originated lottery game of at least one other participating lottery authority (each state is authorized to sell PowerBall TM tickets, which game is originated by all of the participating lottery authorities, Page 7, Lines 17 to 24).

8. As to Claim 2: Each of the participating lottery authorities in '460 originates a respective originated lottery game (Fig. 1a). All of the participating lottery authorities specify in the lottery agreement that each of the participating lottery authorities is

authorized to sell at least one of the lottery tickets of the respective originated lottery game of each of the other of the participating lottery authorities (each participating lottery authority sells PowerBall™ tickets, which are originated by all of the participating lottery authorities, Page 7, Lines 17 to 24).

9. As to Claim 3: '460 teaches at least one of the participating lottery authorities not originating a respective lottery game (multi-jurisdictional lottery may be played as a stand-alone game, Abst., Page 5, Line 3).

10. As to Claim 4: '460 teaches a suitably programmed and constructed lottery computer apparatus (Fig. 2b). The examiner notes that in the specification, the applicants state that the Lottery Authority Administrative Control System (LAACS, 16), the server 18, the database 20, the Master Game Matrix (MGM, 22), the player interactive device 23, the website device 24, the point of sale device 26, the wireless device 28, and the TV device 30 can all be the same device or separate devices (Page 6, Lines 18 to 21). '460 comprises at least one lottery player interactive device that enables the player to purchase at least one of the tickets for a respective originated lottery game of at least one of the participating lotteries (player buys ticket at terminal, Page 8, Lines 11 to 30).

11. As to Claim 5: '460 teaches a lottery computer apparatus (lottery computer 102, Fig. 2b). The lottery computer apparatus has a data communications link for permitting data communications between each lottery computer apparatus (network 105, network interfaces 103, Fig. 2b).

12. As to Claim 6: '460 teaches the lottery player interactive device being a lottery

web service device (Page 9, Lines 1 to 9).

13. As to Claim 7: '460 teaches the lottery player interactive device being a lottery point of sale device (retail terminal, Page 8, Lines 11 to 30).

14. As to Claim 8: '460 teaches the lottery player interactive device being a wireless device (cell phone, Page 27, Line 29).

15. As to Claim 9: '460 teaches the lottery player interactive device being a television device (GUI displayed on television, Page 27, Lines 24 to 29).

16. As to Claim 19: '460 teaches a lottery method for at least two lottery authorities, wherein at least one of the participating lottery authorities originates a respective lottery game comprising a set of tickets (multiple jurisdictions, each with own game, Fig. 1a; multiple tickets, Page 21, Lines 2 to 8). '460 teaches PowerBall TM, which is a multi-state lottery game in which each participating jurisdiction enters into an agreement to sell PowerBall TM tickets (Page 7, Lines 17 to 24). It is inherent that all of the participating lotteries in PowerBall TM specify that at least one of the participating lottery authorities is authorized to sell at least one of the lottery tickets of the respective originated lottery game of at least one other participating lottery authority (each state is authorized to sell PowerBall TM tickets, which game is originated by all of the participating lottery authorities, Page 7, Lines 17 to 24). '460 also teaches a suitable programmed and constructed lottery computer system for implementing this method (Fig. 2b).

17. As to Claim 20: Each of the participating lottery authorities in '460 originates a respective originated lottery game (Fig. 1a). All of the participating lottery authorities

specify in the lottery agreement that each of the participating lottery authorities is authorized to sell at least one of the lottery tickets of the respective originated lottery game of each of the other of the participating lottery authorities (each participating lottery authority sells PowerBall TM tickets, which are originated by all of the participating lottery authorities, Page 7, Lines 17 to 24).

18. As to Claim 21: '460 teaches at least one of the participating lottery authorities not originating a respective lottery game (multi-jurisdictional lottery may be played as a stand-alone game, Abst., Page 5, Line 3).

19. As to Claim 22: '460 teaches the computer apparatus comprising an LAACS (computing apparatus 101 of Fig. 2b able to control input and output of retailer (store) data, making it an LAACS, Page 8, Lines 16 to 17), a database (104, Fig. 2b), a server (computing apparatus 101 of Fig. 2b acting as server for Internet devices 106"), an MGM (lotto site 101 of Fig. 2b able to log purchases through Internet device 106", making it an MGM), and a lottery player interactive device (Internet input device, 106", Fig. 2b).

20. As to Claim 23: '460 teaches at least two respective computer apparatuses, one for each of at least two participating lottery authorities (Figs. 1a, 1b, 2a, and 2b; lotto site 101 connected to local lottery A21 by network, Page 9, Lines 10 to 18).

21. As to Claim 24: '460 teaches the lottery game played over a website (Page 27, 7 to 23).

22. As to Claim 25: '460 teaches the lottery player interactive device being a lottery point of sale device (retail terminal, Page 8, Lines 11 to 30).

23. As to Claim 26: '460 teaches the lottery player interactive device being a wireless device (cell phone, Page 27, Line 29).

24. As to Claim 27: '460 teaches the lottery player interactive device being a television device (GUI displayed on television, Page 27, Lines 24 to 29).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

26. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 28. Determining the scope and contents of the prior art.
- 29. Ascertaining the differences between the prior art and the claims at issue.
- 30. Resolving the level of ordinary skill in the pertinent art.
- 31. Considering objective evidence present in the application indicating obviousness or nonobviousness.

32. Claims 10 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over '460 in view of Walker, et al. (U.S. pre-grant publication 2002/0169019 A1, application 10/162,823).

33. As to Claim 10: '460 teaches all of the elements of Claim 10, but lacks specificity as to the lottery player interactive device being operable for the lottery player to select an auto-purchase feature. '019, however, teaches allowing a lottery player to use an

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auto-purchase feature to purchase lottery tickets on a subscription basis. The player buys conditional tickets that are activated when criteria are met (Para. 10); the tickets are activated a predefined number of times on a subscription basis (Para. 11) for a flat fee. The conditional tickets are activated if the criteria are met (Para. 51) and remain inactivated if the criteria are not met (Para. 52). It would be obvious to one of ordinary skill in the art to apply the auto-purchase feature of '019 to the lottery game of '460. '460 teaches a direct-debit system for withdrawing money from a player's account to purchase lottery tickets (Page 27, Lines 13 to 16). Direct-debits are commonly used for paying bills on a monthly basis, and would be ideal for an auto-purchase feature for buying lottery tickets. The advantages of this combination would be to maintain players' interest in the game by keeping them involved on a regular basis, and to help ensure a steady stream of income for the lottery authority.

34. As to Claim 28: The combination of '460 and '019, as discussed in Para. 33 above, teaches allowing a lottery player to use an auto-purchase feature to purchase lottery tickets on a subscription basis. The player buys conditional tickets that are activated when criteria are met (Para. 10, '019); the tickets are activated a predefined number of times on a subscription basis (Para. 11, '019) for a flat fee. The conditional tickets are activated if the criteria are met (Para. 51, '019) and remain inactivated if the criteria are not met (Para. 52, '019).

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35. Claims 11, 12, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over '460 in view of Nakayama (U.S. pre-grant publication 2003/0037011 A1, application 10/218,660).

36. As to Claim 11: '460 discloses all of the elements of Claim 11, but lacks specificity as to the player interactive device being operable to select and auto-deposit of winnings feature. '011, however, teaches lottery winnings being automatically deposited into a winner's registered account (Para. 103). It would be obvious to one of ordinary skill in the art to apply the auto-deposit feature of '011 to the lottery game of '460. '460 teaches a direct-debit system for withdrawing money from a player's account to purchase lottery tickets (Page 27, Lines 13 to 16). Direct-debits are commonly used for paying bills on a monthly basis, and would be ideal for an auto-purchase feature for buying lottery tickets. The opposite-direct deposit-is commonly used for depositing employees' paychecks on a regular basis for convenience and security, as no checks are sent through the mail. The advantage of this combination would be to enhance the security of the game and the players' convenience by directly depositing the winnings to the players' accounts.

37. As to Claims 12 and 30: The combination of '460 and '011, as discussed in Para. 36 above, teaches automatically notifying lottery winners by email (Para. 103, '011).

38. As to Claim 29: The combination of '460 and '011, as discussed in Para. 36 above, teaches lottery winnings being automatically deposited into a winner's registered account (Para. 103, '011).

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39. Claims 13 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nguyen, et al. (U.S. pre-grant publication 2003/0199320 A1, application 10/459,001).

40. As to Claim 13: '460 discloses all of the elements of Claim 13, but lacks specificity as to the lottery player interactive device being operable to enable the player to select a customized gift pack feature. '320, however, allows a player to select a prize from an assortment of prizes (Para. 54), which may be won in a lottery (Para. 70). It would be obvious to one of ordinary skill in the art to apply the selected prize of '320 to the lottery game of '460. '320 has interactive player terminals (Fig. 1), like those of '460. '320 is also able to debit a players account for opportunities to play (Para. 42), like '460. The advantage of this combination would be to enhance players' interest in the game by providing a greater variety of prizes that can be won.

41. As to Claim 31: The combination of '460 and '320, as discussed in Para. 40 above, allows a player to select a prize from an assortment of prizes (Para. 54, '320), which may be won in a lottery (Para. 70, '320).

42. Claims 14, 18, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over '460 in view of Walker, et al. (U.S. pre-grant publication 2003/0224852 A1, application 10/414,934).

43. As to Claim 14: '460 discloses all of the elements of Claim 14, but lacks specificity as to the lottery player interactive device being operable for enabling the player to select a prize money designation feature. '852, however, teaches that lottery

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winnings may be designated as donations to a charity (donations, Para. 192; video lottery terminals, Para. 49). It would be obvious to one of ordinary skill in the art to apply the money designation feature of '852 to the lottery game of '460. '460 is played on networked lottery terminals (Para. 49, Fig. 1A), like the game of '460 (Fig. 2B; Page 8, Lines 11 to 30). '460 teaches a direct-debit system for withdrawing money from a player's account to purchase lottery tickets (Page 27, Lines 13 to 16). '852 similarly teaches charging a player's bank or credit card account for opportunities to play (Para. 107) and is connected to financial networks for transferring funds (Para. 79). The advantage of this combination would be to enhance players' interest in the game by providing a charitable application of the winners' proceeds, thereby interesting people who might otherwise think gambling is wasteful.

44. As to Claims 18, 32, and 36: The combination of '460 and '852, as discussed in Para. 43 above, teaches that lottery winnings may be designated as donations to a charity (donations, Para. 192; video lottery terminals, Para. 49, '852).

45. Claims 15, 16, 33, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over '460 in view of Shvili (U.S. pre-grant publication 2002/0155885 A1, application 10/042,517).

46. As to Claim 15: '460 discloses all of the elements of Claim 15, but lacks specificity as to a lottery player interactive device being operable for enabling a lottery player to select a lottery pool feature. '885, however, teaches allowing a lottery player to select and join a lottery pool (Fig. 1, Para. 18). It would be obvious to one of ordinary

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skill in the art to apply the lottery pools of '885 to the lottery game of '460. '885 debits the funds wagered from the player's account (Para. 22), like the system of '460 (Page 27, Lines 13 to 16). '885 is meant to be played over the Internet (Para. 13 to 15), like '460 (Page 27, Lines 3 to 23). The advantage of this combination would be to allow a player to join a pool, allowing him or her a greater chance of winning the lottery game.

47. As to Claims 16 and 34: The combination of '460 and '885, as discussed in Para. 46 above, teaches the player being able to select an open pool (Fig. 1, '885).

48. As to Claim 33: The combination of '460 and '885, as discussed in Para. 46 above, teaches allowing a lottery player to select and join a lottery pool (Fig. 1, Para. 18, '885).

49. Claims 17 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of '460 and '885 in view of Wiltshire, et al. (U.S. pre-grant publication 2001/0031661 A1, application 09/803,339).

50. As to Claim 17: The combination of '460 and '885 discloses all of the elements of Claim 17, but lacks specificity as to the lottery player being able to select a closed lottery pool creation feature. '661, however, teaches a closed lottery pool. Para. 54 teaches a pool that a friend has to be invited to join, a closed pool. It would be obvious to one of ordinary skill in the art to apply the closed pool of '661 to the lottery game of the combination of '460 and '885. '661 is capable of being played on the Internet (Figs. 12-20), like the game of '460. '661 also has a debit feature able to debit the player's account for the amount wagered (Para. 71). The advantage of this combination would

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be to enhance players' interest in the game by providing a pool limited to a group of friends or co-workers, for example.

51. As to Claim 35: The combination of '460, '885, and '661, as discussed in Para. 50 above, teaches teaches a closed pool that a friend has to be invited to join (Para. 54, '661).

Citation of Pertinent Prior Art

52. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Interstate Wagering Amendment of 1994, <http://www.gambling-law-us.com/Federal-Laws/interstate-wagering.htm>, downloaded Mar. 25th, 2006, is considered to be relevant. The EBSCO HOST search results for multi-state lotteries, <http://web30.epnet.com/>, downloaded Mar. 25th, 2006, are considered to be relevant. The ProQuest search results for multi-state lotteries, <http://proquest.umi.com/>, downloaded Mar. 25th, 2006, are considered to be relevant. Joao in U.S. pre-grant publication 2003/0224854 A1, application 10/440,888, teaches a lottery with auto-notification. Jawaharlal, et al. in U.S. pre-grant publication 2003/0228910 A1, application 10/458,560, teach a lottery management system. Yacenda in U.S. patent 6,869,358 B2 teaches a governmental lottery system. Stanek in U.S. patent 6,887,152 B2 teaches a multi-jurisdictional lottery system. Fulton in U.S. pre-grant publication 2003/0139212 A1, application 10/335,758, teaches a lottery network. Yacenda in U.S. pre-grant publication 2002/0094858 A1, application 10/000,795, teaches a governmental lottery system. Stanek in U.S. pre-grant

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publication 2003/0069059 A1, application 10/154,645, teaches a multi-jurisdictional lottery system. Petruzzi in U.S. pre-grant publication 2003/0003984 A1, application 10/135,853, teaches a global lottery system. Park in U.S. pre-grant publication 2002/0006821 A1, application 09/897,539, teaches a lottery website selling tickets from multiple states. Muniz in U.S. pre-grant publication 2002/0037766 A1, application 09/961,244, teaches a multi-jurisdictional lottery. Markowicz in U.S. patent 4,842,278 A teaches a multi-state lottery.

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Conclusion

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner
AU 3713


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TC3700